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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,143	12/13/2001	Herbert Peiffer	00/172 MFE	2770

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ProPat, L.L.C.
2912 Crosby Road
Charlotte, NC 28211-2815

EXAMINER

CHEN, VIVIAN

ART UNIT PAPER NUMBER

1773

DATE MAILED: 12/06/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,143

Applicant(s)

PEIFFER ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-7, 9, 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,423,401 (PEIFFER ET AL). Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,423,401 (PEIFFER ET AL) claims a multilayer film having the recited base layer B, sealable outer layer A and cover layer C, said layers having the minimum heat sealing temperature, seal seam strength, surface gas-flow, particle contents, polyester materials, and process of making (patent claims 1-7,10) as recited in the application claims 1-7, 9. However, the patent does not explicitly claim the recited haze or gloss values.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use conventional finishing methods and/or additives to modify the clarity and the surface texture of the film in order to obtain the specific gloss (or lack thereof) and light

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transmittance properties desired for a given usage. It is well known in the art to use polyester films in packaging applications.

3. Claim 8 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,423,401 (PEIFFER ET AL), and further in view of FUNDERBURK ET AL (US 4,493,872) or PEIFFER ET AL (US 6,214,440).

U.S. Patent No. 6,423,401 (PEIFFER ET AL) as relied upon above.

FUNDERBURK ET AL discloses that it is well known in the art to apply a sulfonated copolyester coating derived from 65-96 mol% isophthalic acid, 0-30 mol% of the recited aliphatic dicarboxylic acid, 5-15 mol% of the recited sulfomonomer, and stoichiometric amounts of the recited glycols in order to improve the adhesive properties of polyester films. PEIFFER ET AL '440 discloses that it is well known in the art to apply a sulfonated copolyester surface layer having the composition recited in claim 8 to a polyester film in order to improve the adhesive properties of the polyester film.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the adhesion promoting copolyester of FUNDERBURK ET AL or PEIFFER ET AL '440 in the surface layer of the film claimed in U.S. Patent No. 6,423,401 (PEIFFER ET AL) in order to improve the adhesion properties of the film.

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4. Claims 10-12 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,423,401 (PEIFFER ET AL), and further in view of HIBIYA ET AL (US 6,136,420).

U.S. Patent No. 6,423,401 (PEIFFER ET AL) as relied upon above.

HIBIYA ET AL discloses that it is well known in the art to heat-set polyester films at the conditions recited in claim 10 (lines 49-63, col. 16) in order to improve dimensional stability and to subject the film to conventional adhesion promoting treatments such as corona discharge prior to coating in order to enhance interlayer adhesion (lines 22-59, col. 14). The reference also discloses that it is well known in the art to incorporate scrap material into the film in typical amounts of 5-60 wt% in order to reduce material costs and waste generation.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use conventional heat-setting and adhesion promoting treatments as disclosed in HIBIYA ET AL on the film claimed in U.S. Patent No. 6,423,401 (PEIFFER ET AL) in order to improve the adhesiveness and the stability of the film. It also would have been obvious to recycle scrap film material for economic and environmental reasons. One of ordinary skill in the art would have adjusted the adhesion promoting treatment to optimize the surface tension for a specific coating material as indicated in claim 11.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

NOSE ET AL (US 4,605,591) discloses sulfonated copolyester surface coatings.

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2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (for non-after finals) and (703) 872-9311 (for after-finals).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

December 2, 2002



Vivian Chen
Primary Examiner
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